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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/569,519

02/23/2006

Roman Stauch

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34704 7590 04/21/2009

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

04/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/569,519	<b>Applicant(s)</b> STAUCH, ROMAN	
	<b>Examiner</b> DAVID COMSTOCK	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

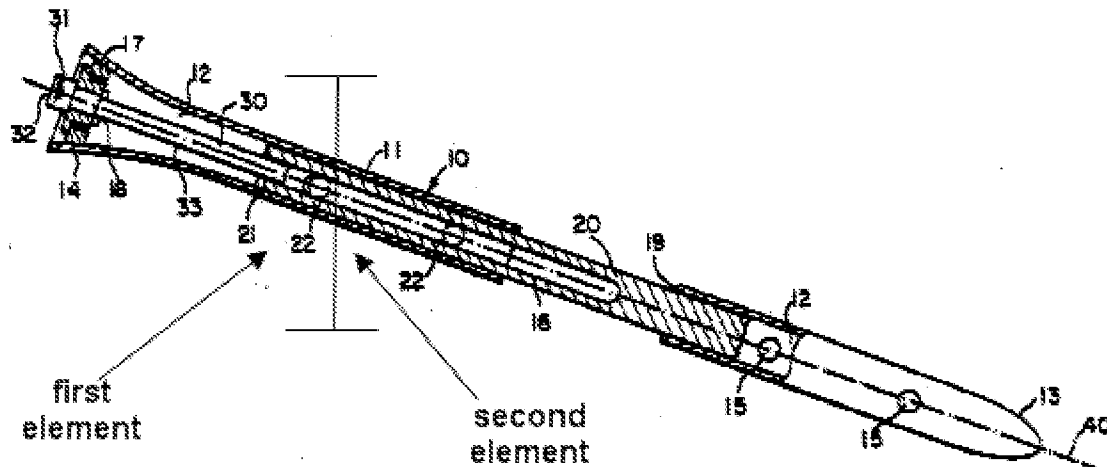
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 12, 15 and 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumgart et al (5,263,955; of record); or in the alternative, under 35 U.S.C. 103(a), as being obvious over Baumgart et al. in view of Taylor et al. (5,601,551; of record).

Baumgart et al. disclose a device comprising a first element and second element (please see the drawing below as depicted from the patent cover page's illustration), an electric motor associated with the first element (Col 2 Lines 10-35), a drive shaft (Col 2 Lines 1-5, in that the drive for longitudinal displacement is interpreted as having a drive shaft), guide means located on the first element (area indicated by 10 in Fig 3) so that the first element and second element move axially relative to one another without radial torsion (Col 1 Lines 10-20), an inner cross section of the second element configured as a cylindrical bore provided with an inner circumferential surface having a thread (Col 3

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Lines 20-40) a radial locking bore provided in the first and second elements (22 and 15, respectively, in Fig 4), and at least one sealing element inserted between the first and second elements (16).



Baumgart et al. disclose that the disclosed device may comprise various cross-sectional configurations including a polygonal cross-section (see, e.g., col. 2, lines 58-63).

Baumgart et al. also teach that the components of the implant should be secured against relative rotation (see, e.g., col. 3, lines 19-22). Therefore, since the device comprises a sleeve configuration wherein one element receives another element, the embodiment wherein a polygonal cross-section is implemented would have correspondingly shaped inner and outer engaging surfaces of a polygonal configuration. Such a configuration would secure against torsion. In addition, or in the alternative, it would have been obvious to have provided the system with correspondingly shaped

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inner and outer engaging surfaces of a polygonal configuration in view of Taylor et al., as follows. Taylor et al. disclose an orthopedic device for imparting linear motion having correspondingly shaped inner and outer engaging surfaces of a polygonal configuration, in order to allow bone elements to be lengthened along an axis while maintaining and controlling the other spatial relations of each bone element and to prevent rotation thereof (see, e.g., Figs. 2-4; col. 1, lines 51-57; col. 3, lines 4-8; and col. 4, lines 25-47). It would have been obvious to a person having ordinary skill in the art to have provided the device of Baumgart et al. with correspondingly shaped inner and outer engaging surfaces of a polygonal configuration, in view of Taylor et al., in order to allow bone elements to be lengthened along an axis while better maintaining and controlling the other spatial relations of each bone element and to prevent rotation thereof.

Claims 13, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgart et al. (5,263,955; of record) alone or in view of Taylor et al. (5,601,551; of record), as applied to claim 11 above, and further in view of Betz et al. (6,245,075; of record).

The device of the combination of Baumgart et al. alone or in view of Taylor et al. discloses the claimed invention except for a planetary roller system and a sensor means connected with an electronics unit. Betz et al. disclose a distraction device for extending bones comprising planetary rollers (Fig 1 Elements 19) and a sensor means connected with a telemetry system (Col 3 Lines 5-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Baumgart et al alone or in view of Taylor et al. with planetary rollers and a

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sensor means, in view of Betz et al., to provide an alternative means of accurately extending the length of a patient's bone.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgart et al. (5,263,955; of record) and Betz et al. (6,245,075; of record) and optionally in view of Taylor et al. (5,601,551; of record), as applied to claim 17 (and 14 and 11) above, and further in view of Er et al (610415; of record).

The device of the combination of Baumgart et al., Betz et al. and optionally Taylor et al. disclose the claimed invention except for a data transmission unit. Er et al. disclose an implantable medical device comprising a data transmitter unit (130 in Fig 4a). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the data transmitter unit of Er et al. in the device of the combination of Baumgart et al., Betz et al., and optionally Taylor et al., to offer an equivalent means of transmitting data from the device to an external source in the OR.

### ***Response to Arguments***

Applicant's arguments with respect to independent claim 11 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment, further amending independent claim 11, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733